

Applicant: Holger KLAPPROTH et al.  
Application No. 09/889,935  
Attorney Docket No. 105032-991220

**REMARKS**

New claim 24 replaces claim 11 and is supported by teachings throughout the instant specification. Copolymers are taught in fourth full paragraph on page 5 of the instant specification, and in the priority document filed 25 January 1999. As no issue of new matters arises, and new claim 24 places the application in condition for allowance, or at the least simplifies issues, entry of the new claim and amendments is requested respectfully.

I. The Examiner alleged that claims 11-14 do not enjoy the benefit of priority to the parent EP application filed on 25 January 1999 (i.e., EP 99101340).

The issue of support does not sound in the consideration of new claim 24, which replaced claim 11.

II. The specification was objected to because of the format.

The specification has been amended to include a section providing a brief description of the figures. Hence, the objection can be removed.

III. The Declaration was alleged to be defective.

An Application Data Sheet (ADS) was filed on 5 December 2001 providing the mailing address of each inventor. Attached hereto is an updated ADS containing the foreign priority information.

IV. Claim 13 was objected to for allegedly being improperly multiply dependent.

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With the cancellation of claim 11, the issue no longer exists.

V. In item 7 on page 4 of the Office Action under 35 U.S.C. §112 second paragraph. The Examiner raised plural issues as to claim 11.

The rejection is traversed for the following reasons.

As claim 11 is canceled, the rejection is moot. The issues raised by the Examiner do not apply to new claim 24. For example, claim 24 recites making a monolayer. The polyfunctional nature is clearly noted in claim 24. Antecedent basis exists. The claim contains affirmative steps.

Thus, the claims are clear, definite and distinct. In view thereof, withdrawal of the rejection is in order.

VI. Claims 11-13 were alleged to be anticipated by Prucker et al. (Macromolecules (1998) 31:602-613) under 102(b).

The rejection is traversed for the following reasons.

Prucker et al. do not teach copolymer chains. Thus, anticipation does not exist and the rejection must be removed.

VII. Claims 11-13 were alleged to be anticipated by Prucker et al. (Macromolecules (1998) 31:592-601) under 102(b).

The rejection is traversed for the following reasons.

Prucker et al. do not teach copolymer chains. Thus, anticipation does not exist and the rejection must be removed.

VIII. Claims 11, 13 and 14 were alleged to be anticipated by Coté et al. (U.S. Patent No. 6,485,703) under 102(e).

The rejection is traversed for the following reasons.

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Contrary to the assertion by the Examiner, the initiators referred to in the cited patent are unsuitable for attaching a polymer to a surface. As noted in Figure 3 of the cited patent, the initiator DMPA forms methoxy radicals. There is no teaching or suggestion in the cited patent that the non-polar methoxy radicals would link the polymer to the surface. There are other polar sites more likely to be involved in binding to a surface.

Hence, the cited patent does not teach each and every element of the claimed invention as explained above, including the step of covering the surface with polymerization initiator having groups for linking to a surface.

Accordingly, withdrawal of the rejection is in order.

IX. Claims 11-13 were alleged to be anticipated by Hawker et al. (U.S. Patent No. 6,413,587) under 102(a).

The rejection is traversed for the following reasons.

Hawker et al. is not an effective reference against the instantly claimed invention. For example, copolymers and the various kinds of initiators are taught in EP 99 10 1340 having a filing date of 25 January 1999. Thus, the rejection is improper and must be removed.

X. Claim 12 was alleged to be unpatentable over Coté et al. ('587 patent) in view of Lennox et al. (U.S. Patent 6,130,037) under 103(a).

The rejection is traversed for the following reasons.

The deficiencies of the '587 patent as to the teachings and suggestions therein in light of the claimed invention, and beyond the deficiencies referred to by the Examiner, are provided hereinabove, and those arguments are incorporated herein by reference.

The '037 patent does not cure those deficiencies of the '587 patent with respect to the claimed invention. This, even if, arguendo, the teachings of the two

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patents could be combined, the aggregate teachings neither anticipate nor suggest the claimed invention.

Hence, a prima facie case of obviousness has not been made and withdrawal of the rejection is in order.

### **CONCLUSION**

Applicants submit that the pending claims are in condition for allowance. Reexamination, reconsideration, withdrawal of the objection and rejections, and early indication of allowance are requested respectfully. If any questions remain, the Examiner is urged to contact the undersigned at the local exchange noted below. If any fees are found to be applicable, please charge any additional fees or make any credits to Deposit Account No. 07-1896.

Respectfully submitted,



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